

REMARKS

Claims 60-83 are pending in the present application; claim 60 is the sole independent claim.

The Examiner rejected all of the pending claims under 35 U.S.C. § 103(a) as unpatentable over Jachmann (U.S. Patent No. 5,146,439) in view of Kikinis (U.S. Patent No. 5,875,436) and further in view of Clark (U.S. Patent No. 5,974,389).

The Office Action Is Not Complete

An Examiner's action is required to be complete. 37 C.F.R. § 1.104(b). In rejecting claims for want of novelty or for obviousness, the Examiner is to designate the particular part of a reference relied on, and to clearly explain the pertinence of each reference. 37 C.F.R. § 1.104(c)(2). Applicant respectfully submits that the Office action is not complete, and requests that the Examiner, if the pending rejections are to be maintained, reissue a non-final Office action correcting the following errors and omissions.

In particular, the citations to Jachmann and Kikinis constitute clear error. The entire portion of the Office action attributed to Jachmann and Kikinis (Office action, first half of para.s 6 and 8) is identical to that from a pre-RCE action in which the Examiner asserted these references against *a set of different claims that are no longer pending in this application*. In other words, the present citations to Jachmann and Kikinis refer solely to claim language, and even claim numbers, that are not pending in this RCE application. Thus, this error precludes Applicant from providing a responsive reply to the associated rejections, since it is unclear which parts of these references are being applied to the which parts of the pending claims, or whether the Examiner intended to apply these references to the pending claims at all.

Additionally, the citation to Clark omits identifying where in the reference there is any teaching or suggestion for any particular claim element. For example, independent claim 60 recites seven modules along with 33 functional claim elements that these modules are configured to perform. In the Office action, the Examiner does not cite to any disclosure in Clark that attempts to identify a teaching or suggestion for any of these 33 functional claim elements. With respect to all of the dependents claims (61-83), the Examiner provides only one citation to Clark

that is a *verbatim copy* of the Clark citation used for independent claim 60, giving no indication how the Examiner is intending to apply Clark against each respective dependent claim element. Thus, not only are these omnibus rejections improper (M.P.E.P. § 707.07(d)), but they also preclude Applicant from providing a responsive reply to the associated rejections since it is unclear which parts of the reference are being applied to the which parts of the pending claims, if at all.

Moreover, based on these errors and omissions, Applicant is unable to determine which reference is being applied to which claim elements for any pending claim, precluding Applicant from providing responsive 35 U.S.C. § 103 arguments in reply.

Accordingly, for at least these reasons, Applicant respectfully submits that the Office action is not complete, and requests that the Examiner, if the pending rejections are to be maintained, reissue a non-final Office action correcting the above-mentioned errors and omissions.

Statement of Substance of Interview

Applicant's representative thanks Examiner Akers for the courtesies extended at the telephonic interview on August 20, 2003, and provides this Statement of Substance of Interview in compliance with M.P.E.P. § 713.04:

- (A) Exhibits. No exhibit or demonstration was conducted.
- (B) Claims. All pending claims (60-83) were discussed.
- (C) Prior art. Jachmann (U.S. Patent No. 5,146,439), Kikinis (U.S. Patent No. 5,875,436) and Clark (U.S. Patent No. 5,974,389) were mentioned.
- (D) Amendments. No proposed amendments were discussed.
- (E) Principal arguments by Applicant. The cited art does not disclose or suggest the invention as claimed. The Examiner's Office action is deficient because it fails to identify where the claim limitations are supposedly found in the cited art. Additionally,

substantial portions of the Office action are copied from an earlier Office action, and those portions discuss claim language that is no longer pending in the present case.

- (F) Other matters. No other pertinent matters were discussed.
- (G) No agreement. Although no agreement was reached between Applicant's representative and the Examiner, the Examiner affirmed his willingness to work with Applicant in identifying and allowing any inventive subject matter. The Examiner asked that, although the missing claim elements were not delineated in the Office action, Applicant specifically point out in Applicant's response the claim elements missing from the cited art, and the Examiner will respond to each element in turn.

The Independent Claim Patentably Defines the Invention Over Jachmann, Kikinis and Clark

The Examiner rejected independent claim 60 under 35 U.S.C. § 103(a) as unpatentable over Jachmann (U.S. Patent No. 5,146,439) in view of Kikinis (U.S. Patent No. 5,875,436) and further in view of Clark (U.S. Patent No. 5,974,389).

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F. 2d 931, 934 (Fed. Cir. 1990); *In re Bond*, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. To establish a prima facie case of obviousness, the Examiner must show that three basic criteria are met. M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when so modified or combined, must teach or suggest all of the claim limitations. *Id.* Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Finally, in discharging the initial burden of establishing a prima facie

case, the Examiner must make particular findings as to establish the motivational element. In re Kotzab, 217 F.3d 1365 (Fed. Cir. 2000). That is, the PTO cannot rely on mere conclusory statements but instead must explain its reasoning why one of ordinary skill would be motivated to select the references and combine them to reach the claimed invention, and must provide evidence to support such a motivation. In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

Applicant respectfully submits that none of these criteria for obviousness are met for at least the following reasons.

The Cited References Fail To Teach or Suggest Automatically Generating a Report Showing the Number of Charts Assigned To Each Department in the Medical Office

Independent claim 60 recites, in part, a management tracker module configured to automatically generate a report showing the number of charts assigned to each department in a medical office. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation, and the Examiner has not even cited any teaching or suggestion for this missing claim element. See Office action, pages 2-3, para. 5.

If the Examiner is impliedly taking official notice of a teaching or suggestion of automatically generating a report showing the number of charts assigned to each department in a medical office, then Applicant respectfully traverses this implied taking and officially requests that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Jachmann and Kikiñis are merely directed to transcription management systems. Clark is merely directed to entering and retrieving data in electronic medical reports. There is no teaching or suggestion in any of these references of anything related to *automatically generating reports of the number of charts assigned to each medical office department* as claimed.

Applicant directs the Examiner to the remarks provided in the Preliminary Amendment (RCE), filed April 30, 2003. In these remarks, Applicant clearly explains how the present invention is directed to automating labor-intensive tasks that relate to the overall administration of a medical office, resulting in a great reduction in the amount of hours typically spent on

administrative tasks. Automatically generating reports of the number of charts assigned to each medical office department clearly saves the time of an administrator or provider that would otherwise be spent manually or at a computer determining office department workload, as would be the case in the absence of the present invention.

Accordingly, Applicant respectfully submits that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least this reason, the sole pending independent claim 60, along with its respective dependent claims 61-83, are not rendered obvious under 35 U.S.C. § 103(a).

The Cited References Fail To Teach or Suggest Automatically Generating a Report Showing an Age of Charts Assigned To Each Department

Independent claim 60 recites, in part, a management tracker module configured to automatically generate a report showing an age of charts assigned to each department for ascertaining department workload status. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation, and the Examiner has not even cited any teaching or suggestion for this missing claim element. See Office action, pages 2-3, para. 5.

If the Examiner is impliedly taking official notice of a teaching or suggestion of automatically generating a report showing an age of charts assigned to each department for ascertaining department workload status, then Applicant respectfully traverses this implied taking and officially requests that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Again, Jachmann and Kikinjs are merely directed to transcription management systems. Clark is merely directed to entering and retrieving data in electronic medical reports. There is no teaching or suggestion in any of these references of anything related to *automatically generating reports of an age of charts assigned to each department* as claimed.

As mentioned above, the present invention is directed to automating labor-intensive tasks that relate to the overall administration of a medical office, resulting in a great reduction in the

amount of hours typically spent on administrative tasks. Automatically generating reports of the age of charts assigned to each department clearly saves the time of an administrator or provider that would otherwise be spent manually or at a computer determining office department workload status, as would be the case in the absence of the present invention.

Accordingly, Applicant respectfully submits that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least this reason, the sole pending independent claim 60, along with its respective dependent claims 61-83, are not rendered obvious under 35 U.S.C. § 103(a).

The Cited References Fail To Teach or Suggest Automatically Generating a Report Identifying No-Show Patients

Independent claim 60 recites, in part, a management tracker module configured to automatically generate a report identifying no-show patients. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation, and the Examiner has not even cited any teaching or suggestion for this missing claim element. See Office action, pages 2-3, para. 5.

If the Examiner is impliedly taking official notice of a teaching or suggestion of automatically generating a report identifying no-show patients, then Applicant respectfully traverses this implied taking and officially requests that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Again, Jachmann and Kikinis are merely directed to transcription management systems. Clark is merely directed to entering and retrieving data in electronic medical reports. There is no teaching or suggestion in any of these references of anything related to *automatically generating reports identifying no-show patients* as claimed.

As mentioned above, the present invention is directed to automating labor-intensive tasks that relate to the overall administration of a medical office, resulting in a great reduction in the

amount of hours typically spent on administrative tasks. Automatically generating reports identifying no-show patients clearly saves the time of an administrator or provider that would otherwise be spent manually or at a computer tracking down which patients neglected their doctor's appointments, as would be the case in the absence of the present invention.

Accordingly, Applicant respectfully submits that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least this reason, the sole pending independent claim 60, along with its respective dependent claims 61-83, are not rendered obvious under 35 U.S.C. § 103(a).

The Cited References Fail To Teach or Suggest Maintaining Provider Workload Information for Determining New Patient Assignments

Independent claim 60 recites, in part, a provider tracker module configured to maintain provider workload information for determining to whom to assign new patients. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation, and the Examiner has not even cited any teaching or suggestion for this missing claim element. See Office action, pages 2-3, para. 5.

If the Examiner is impliedly taking official notice of a teaching or suggestion of maintaining provider workload information for determining new patient assignments, then Applicant respectfully traverses this implied taking and officially requests that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Again, Jachmann and Kikinis are merely directed to transcription management systems. Clark is merely directed to entering and retrieving data in electronic medical reports. There is no teaching or suggestion in any of these references of anything related to maintaining *provider workload information for determining new patient assignments* as claimed.

As mentioned above, the present invention is directed to automating labor-intensive tasks that relate to the overall administration of a medical office, resulting in a great reduction in the

amount of hours typically spent on administrative tasks. Maintaining provider workload information for determining new patient assignments clearly saves the time of an administrator or provider that would otherwise be spent manually or at a computer assessing each provider's workload in order to assign new patients, as would be the case in the absence of the present invention.

Accordingly, Applicant respectfully submits that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least this reason, the sole pending independent claim 60, along with its respective dependent claims 61-83, are not rendered obvious under 35 U.S.C. § 103(a).

The Cited References Fail To Teach or Suggest Providing Access to Management Reports for Each Department

Independent claim 60 recites, in part, an administrative tracker module configured to provide access to management reports for each department. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation, and the Examiner has not even cited any teaching or suggestion for this missing claim element. See Office action, pages 2-3, para. 5.

If the Examiner is impliedly taking official notice of a teaching or suggestion of providing access to management reports for each department, then Applicant respectfully traverses this implied taking and officially requests that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Again, Jachmann and Kikinis are merely directed to transcription management systems. Clark is merely directed to entering and retrieving data in electronic medical reports. The Examiner cited Clark for generally teaching an administrative module based on FIG. 1 (Office action, page 3, para. 5), but it is clear that Clark only discloses insurance administrator's computer 116, a terminal into which an administrator enters patient information and insurance identification data for the electronic medical report (Clark, FIG. 1 and col. 4, lines 13-15). There

is no teaching or suggestion in any of these references of anything related to providing access to *management reports for each department* as claimed.

As mentioned above, the present invention is directed to automating labor-intensive tasks that relate to the overall administration of a medical office, resulting in a great reduction in the amount of hours typically spent on administrative tasks. Providing access to management reports for each department clearly saves the time of an administrator or provider that would otherwise be spent manually determining where office inefficiencies lie, as would be the case in the absence of the present invention.

Accordingly, Applicant respectfully submits that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least this reason, the sole pending independent claim 60, along with its respective dependent claims 61-83, are not rendered obvious under 35 U.S.C. § 103(a).